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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/998,455 | 11/29/2001 | Timothy S. December | IN-5264 | 6016 |
| 26922 | 7590 | 02/25/2004 | EXAMINER | |
| BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442 | | | MAYEKAR, KISHOR | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1753 | |

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,455

Applicant(s)

DECEMBER, TIMOTHY S.

Examiner

Kishor Mayekar

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-11-2002.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to a method of making a cured multiplayer coating, classified in class 204, subclass 484+.
 - II. Claim 25, drawn to a multiplayer coating, classified in class 428, subclass 416+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown:
 - (1) that the process as claimed can be used to make other and materially different product or
 - (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).In the instant case the product as claimed as claimed can be made by an all non-electrophoretic process.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney M. Morgan on 2/18/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claim 25 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2 and 4-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over BATZILL et al. (4,988,420), a reference cited by Applicant. The reference's invention is directed to an electrophoretically overcoatable coating applied by electrocoating. The reference discloses a process comprises all the steps as claimed (col. 2, lines 3-48, col. 3, lines 1-4 and lines 16-22, col. 7, lines 12-16). The difference between the reference and the above claims is whether the reference's electrophoretically overcoatable coating has the electrical conductivity within the recited range. Although the reference is virtually silent in regards to the electrical conductivity of the electrophoretically overcoatable coating, the reference's process appears to lead on of ordinary skill in the art towards the recited conductivity range in absence of evidence to the contrary.

7. Claims 1-17, 19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over RICHARDSON (5,178,736). The reference's invention is directed to a light colored conductive paint. The reference discloses

- in col. 1, line 68 through col. 2, line 36 that the conductive paint allows re-electrocoating over the initial electrocoat layer or improves transfer

efficiency of electrostatic spraying over the electrocoat layer for improved edge coverage;

- in Example 1, that the conductive paint is formed by electrophoretic deposition of a curable coating composition to a substrate to establish a coated substrate, the curable coating composition containing the recited (i)-(iii) and by subjecting the coated substrate to an amount of energy to cause the coated substrate to become a conductive coated substrate having an electrical conductivity of 160 Ransburg unit; and
- in Example 2 the recited step (C) and (D).

The difference between the reference and the instant claims is whether the conductive paint is within the recited conductivity range of Siemens/cm. Although the reference is virtually silent in regards to the unit of electrical conductivity (Siemens/cm) to the conductive paint, the reference's appears to lead one of ordinary skill in the art towards the recited conductivity range in absence of evidence to the contrary.

As to each of the subject matters in claims 5, 7, 11-17 and 22-24, the selection of any of known equivalent coating compositions and curing process would have been within the level of ordinary skill in the art.

As to the subject matters of claims 9-10, since the reference discloses the use of carbon black is known for imparting conductive to the coated film (col. 2, lines 23-36), the substitution would also have been within the level of ordinary skill in the art.

8. Claims 1, 2 and 4-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over PALAIKA et al. (6,248,225), another reference cited by Applicant. The reference's invention is directed to a process for forming a two-coat electrodeposited composite coating. The reference discloses that the process comprises all the steps as claimed (col. 2, line 60 through col. 4, line 65, col. 5, lines 25-30; col. 6, lines 12-29 and col. 12, lines 28-51). The difference between the reference and the above claims is the overlapping of the recited range of electrical conductivity of the conductive coated substrate where the unit of Siemens/cm is equal to the unit of mhos/cm or the unit of $(\text{ohm-cm})^{-1}$. It has been settled that the disclosure in the prior art of any value within the claimed range is an anticipation of that range. And where the range overlap disclosed by the prior, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's

teachings because overlapping ranges have been held to be obvious, *In re Wertheim* 191 USPQ 90.

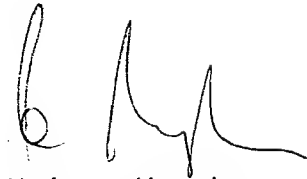
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/998,455
Art Unit: 1753

Page 8

A handwritten signature in black ink, appearing to read 'Kishor Mayekar', located above the printed name.

Kishor Mayekar
Primary Examiner
Art Unit 1753